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EXAMINER

POPHAM, JEFFREY D

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/930,113

Applicant(s)

KING ET AL.

Examiner

Jeffrey D. Popham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Remarks***

Claims 1-31 are pending.

1. Included is an English machine-translation of Merrien (PCT No. WO9857474) obtained from babelfish.altavista.com. The machine-translation has numerous misspellings and the like (ex. chart in place of card/smartcard), but since applicant has included this PCT in an IDS and have displayed thorough knowledge of what is disclosed in Merrien via the arguments filed 5/11/2005, this translation should be suitable.

***Response to Arguments***

2. Applicant's arguments, see arguments, filed 5/11/2005, with respect to the rejection(s) of claim(s) 1-31 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Merrien (PCT No. WO9857474).

On page 13 of applicant's response, it is suggested that the protection code does not supply a network identity, which is true; the protection code of Walters is used for authorization. However, in Walters, at Column 5, lines 36-51 it can be seen that once the protection code authorizes use of the memory card, then data can be read from the card, which, in the combination of Merrien-Walters, is the network identity.

***Specification***

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3. The disclosure is objected to because of the following informalities:
- On Page 32, lines 1-2, the specification states that the PSU is connected to the motherboard via a short harness 40. This conflicts with what is said on Page 10 of the applicant's remarks, since a short harness is not a smart card reader. Reference numeral 40 is used throughout the specification to refer to the smart card reader, and should only be used as such.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 10, 13, 15, 20, 23, 25, 26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien (PCT No. WO9857474) in view of Walters (U.S. Patent 5,357,573).

Regarding Claim 1,

Merrien discloses a processing unit connectable to a data communications network, the processing unit having a device reader (Page 15, lines 12-23) (Translation, Detailed Description, Paragraph 1) for a portable storage device that includes storage operable to supply a network identity (Page 16, line 18 to Page 17,

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line 2) (Translation, Detailed Description, Paragraph 5) for the processing unit and an access controller (Page 18, line 26 to Page 19, line 22) (Translation, Detailed Description, Paragraph 8), the access controller being operable to prevent unauthorized reading and writing to the storage (Page 18, line 26 to Page 19, line 22) (Translation, Detailed Description, Paragraph 8), the processing unit being operable to read the supplied network identity only after authentication has taken place (Page 18, line 26 to Page 19, line 22) (Translation, Detailed Description, Paragraph 8). Merrien does not disclose the method of first attempting to write to the storage device and, only once the write has failed, to read the network identity.

Walters, however, discloses that the processing unit is operable, before reading from the portable storage device, to attempt a write to the storage of the portable storage device, and, on determining that the write has failed, to read a protection code, authorizing the reading of data on the card (Column 4, line 62 to Column 5, line 51). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the memory card of Walters into the smart card system of Merrien in order to verify that the card input to the system was an approved card that could be used with the system.

Regarding Claim 10,

Claim 10 is a program claim that corresponds to system claim 1 and is rejected for the same reasons.

Regarding Claim 15,

Claim 15 is a program on carrier medium claim that corresponds to system claim 1 and is rejected for the same reasons.

Regarding Claim 20,

Claim 20 is a method claim that corresponds to system claim 1 and is rejected for the same reasons.

Regarding Claim 25,

Claim 25 is a system claim that is broader than system claim 1 and is rejected for the same reasons.

Regarding Claim 26,

Claim 26 is a system claim that is broader than system claim 1 and is rejected for the same reasons.

Regarding Claim 4,

Merrien discloses that the portable storage device is a smart card (Page 15, lines 12-23) (Translation, Detailed Description, Paragraph 1), the access controller is a microcontroller or microprocessor (Page 23, lines 5-21) (Translation, Detailed Description, Paragraph 14), and the device reader is a smart card reader (Page 15, lines 12-24; and Page 17, line 3 to Page 18, line 3) (Translation, Detailed Description, Paragraphs 1 and 6).

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Regarding Claim 13,

Claim 13 is a program claim that corresponds to system claim 4 and is rejected for the same reasons.

Regarding Claim 23,

Claim 23 is a method claim that corresponds to system claim 4 and is rejected for the same reasons.

Regarding Claim 30,

Claim 30 is a system claim that is broader than system claim 4 and is rejected for the same reasons.

Regarding Claim 29.

Merrien discloses that the access controller is a microcontroller (Page 23, lines 5-21).

5. Claims 2, 11, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Braithwaite (U.S. Patent 5,644,444).

Regarding Claim 2,

Merrien discloses copying the supplied network identity from a data carrier to a second memory location and to use the supplied network identity (Page 16, line 18 to Page 17, line 2; and Page 18, line 26 to Page 19, line 22) (Translation, Detailed Description, Paragraphs 5 and 8). Merrien does not disclose attempting a write,

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then reading, or the detection of a portable storage device upon powering up of the processing unit.

Walters discloses attempting a write to the storage of the portable storage device, and on determining that the write has failed, to copy data from the device (Column 4, line 62 to Column 5, line 21), but does not disclose the detection of a portable storage device upon powering up of the processing unit.

Braithwaite, however, discloses that the processing unit is operable, on being powered up, to determine whether a said portable storage device is present in the device reader (Column 9, lines 30-41). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the write protection scheme of Braithwaite into the smart card system of Merrien as modified by Walters in order to properly detect a portable storage device so as to continue operations without delay.

Regarding Claim 11,

Claim 11 is a program claim that corresponds to system claim 2 and is rejected for the same reasons.

Regarding Claim 21,

Claim 21 is a method claim that corresponds to system claim 2 and is rejected for the same reasons.



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6. Claims 3, 12, 22, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Hellman (U.S. Patent 4,200,770).

Regarding Claim 3,

Merrien discloses that the processing unit is operable to modify content of the portable storage device on the condition that proper authentication and encryption have taken place (Page 18, line 26 to Page 19, line 22) (Translation, Detailed Description, Paragraph 8), but does not disclose key exchange or key-to-key encryption.

Hellman, however, discloses key-to-key encryption (Column 8, line 65 to Column 9, line 25) and a key exchange method comprising a transmitter that supplies a key to a receiver (Column 9, lines 7-8), and, in response to receipt of a return key from the receiver (Column 9, lines 9-10), to send an encrypted message to the receiver (Column 9, lines 20-23). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the key exchange and encryption schemes of Hellman into the smart card system of Merrien as modified by Walters because Merrien discloses that any convenient or conventional encryption scheme may be used in the system (Merrien, Page 18, line 26 to Page 19, line 22).

Regarding Claim 12,

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Claim 12 is a program claim that corresponds to system claim 3 and is rejected for the same reasons.

Regarding Claim 22,

Claim 22 is a method claim that corresponds to system claim 3 and is rejected for the same reasons.

Regarding Claim 27,

Claim 27 is a system claim that is broader than system claim 3 and is rejected for the same reasons.

Regarding Claim 28,

Merrien discloses that the access controller is subsequently operable to respond to an encrypted command from the processing unit to modify the content of the storage in the portable storage device (Page 18, line 26 to Page 19, line 22) (Translation, Detailed Description, Paragraph 8).

7. Claims 5, 14, 24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of "Windows NT Server".

Regarding Claim 5,

Merrien as modified by Walters does not disclose a MAC address.

Windows NT Server, however, discloses that the network identity comprises a MAC address (Page 12, Paragraphs 2 and 3).

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It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the ARP protocol of Windows NT Server with the smart card system of Merrien as modified by Walters in order to obtain a (physical) MAC address of a computer from the (logical) IP address of that computer.

Regarding Claim 14,

Claim 14 is a program claim that corresponds to system claim 5 and is rejected for the same reasons.

Regarding Claim 24,

Claim 24 is a method claim that corresponds to system claim 5 and is rejected for the same reasons.

Regarding Claim 31,

Claim 31 is a system claim that is broader than system claim 5 and is rejected for the same reasons.

8. Claims 6, 7, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Combaluzier (U.S. Patent 5,973,475).

Regarding Claim 6,

Merrien discloses that the processing unit comprises circuitry to allow the processing unit to control functions of the processing unit (Page 16, lines 6-17) (Translation, Detailed Description,

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Paragraph 4), but does not disclose that the circuitry is a service processor.

Combaluzier, however, discloses that the processing unit comprises a service processor, the service processing being programmed to control reading of the portable storage device (Column 4, lines 22-33). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the cellular telephone of Combaluzier into the smart card system of Merrien as modified by Walters in order to identify the user and authorize the use of the cellular telephone, as well as perform any needed transferring of data between the portable storage device and the processing unit (Column 4, lines 34-55).

Regarding Claim 16,

Claim 16 is a program claim that corresponds to system claim 6 and is rejected for the same reasons.

Regarding Claim 7,

Combaluzier discloses that the service processor is a microcontroller (Column 4, lines 22-33).

Regarding Claim 17,

Claim 17 is a program claim that corresponds to system claim 7 and is rejected for the same reasons.

Regarding Claim 18,

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Merrien as modified by Walters does not disclose that the program is run on a microprocessor.

Combaluzier, however, discloses that microprocessor controls the operations of the processing unit (Column 4, lines 22-33).

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Teppler (U.S. Patent 6,792,536).

Merrien as modified by Walters does not disclose that the processing unit is a server computer.

Teppler, however, discloses that the processing unit is a server computer (Column 14, lines 32-37; and Column 20, lines 7-18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the smart card system of Teppler into the smart card system of Merrien as modified by Walters in order to provide much interoperability and to ensure that secure messaging is done within a protected server security parameter.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Hastings (U.S. Patent 5,460,441).

Merrien as modified by Walters does not disclose that the processing unit is a rack mountable computer server.

Hastings, however, discloses that the processing unit is a rack mountable computer server (Column 3, line 48 to Column 4, line 17). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the server rack system of Hastings into the smart card system of Merrien as modified by Walters in order to have the server(s) disposed in a unique manner so as to provide substantially improved access thereto.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters and Combaluzier, further in view of Teppler.

Merrien as modified by Walters does not disclose that the processing unit is a server or that the microcontroller is operable as a service processor.

Combaluzier discloses that the microcontroller is operable as a service processor and connected to read the content of storage in a portable storage device mounted in the portable storage device (Column 4, lines 22-33), but does not disclose that the processing unit is a server computer.

Teppler, however, discloses that the processing unit is a server computer (Column 14, lines 32-37; and Column 20, lines 7-18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the smart card system of Teppler into the smart card system of Merrien as modified by Walters and Combaluzier

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in order to provide much interoperability and to ensure that secure messaging is done within a protected server security parameter.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571)272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**MATTHEW SMITHERS**  
**PRIMARY EXAMINER**  
*Art Unit 2137*